

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 2, 8, 13, and 22 are requested to be canceled.

Claims 1, 3, 7, 9-12, 14-21, and 23-27 remain pending in the present application.

#### **I. Entry of Amendments**

Claims 3, 17, and 21 have been amended to correct a typographical error. Claims 7, 9, 20, and 27 have been amended to claim only “non-transitory computer readable medium.” Claims 1 and 7 have been amended to include features previously presented in dependent Claims 2 and 8 (now canceled). Applicant asserts that these amendments do not require a new search, and respectfully requests entry of the amendments.

#### **II. Claim Rejections under 35 U.S.C. § 112**

On page 2 of the Office Action, Claims 21-26 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claim 21 to address this rejection. Applicant has also amended Claim 3, in a similar fashion. Accordingly, Applicant respectfully requests withdrawal of this rejection.

#### **III. Claim Rejections under 35 U.S.C. § 101**

On page 2 of the Office Action, Claims 7-9, 20 and 27 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7, 9, 20, and 27, drawn to a computer readable medium (“CRM”), stand rejected under 35 U.S.C. § 101 as “directed to non-statutory subject matter.” Applicant respectfully disagrees. *Nuijten* holds that claims solely reciting “physical but transitory forms of signal transmission such as radio broadcasts, electrical signals through a wire, and light pulses through

a fiber-optic cable” are not directed to statutory subject matter. *In re Nuijten*, 500 F.3d 1346, 1353-1357 (Fed. Cir. 2007). That is, only “Nuijten’s signals, ***standing alone***, are not ‘manufactures’ under the meaning of that term in § 101.” *Nuijten* at 1357 (Emphasis added). Notably, none of the claims at issue in *Nuijten* were CRM claims. To the contrary, the Court in *Nuijten* explicitly points out that the inventor was allowed a claim directed to “‘a ***storage medium having stored thereon a signal*** with embedded supplemental data,’ where the ***stored signal*** has essentially the encoding properties described above.” *Nuijten* at 1351 (emphasis added). Accordingly, there is no proper basis for the Office Action’s blanket allegation that CRM claims lacking the limitation “non-transitory” are per-se non-statutory subject matter.

The words of a claim must be given their plain meaning unless such meaning is inconsistent with the specification, where plain meaning refers to the ordinary and customary meaning given to the term by those skilled in the art. MPEP §2111.01. “The ordinary and customary meaning of a term may be evidenced by a variety of sources, including the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *See* MPEP §2111.01.

Further, Applicant notes that the Board of Patent Appeals and Interferences (BPAI) has declined, absent evidence to the contrary, to broadly interpret the phrase “computer readable medium” to include propagating signals. *See, e.g., Ex Parte Azuma*, Appeal No. 2009-003902, (B.P.A.I., September 14, 2009); *Ex parte Gutta*, 93 USPQ2d 1025, 1034 (B.P.A.I., August 10, 2009, *precedential*); *Ex parte Daughtrey*, Appeal No. 2008-000202 (B.P.A.I., July 31, 2009). For example in *Daughtrey*, the BPAI held

[I]t does not appear that “computer readable medium” had any commonly-recognized understanding in the art at the time of Appellant’s invention. As such, we decline to adopt a definition of the phrase “computer readable medium” that broadly includes signals, when the Appellant has clearly stated on the record that he did not intend the phrase to include signals.

Applicant respectfully submits that, in view of the foregoing, a person skilled in the art would not have taken the ordinary and customary meaning of the phrase “computer readable medium” to include embodiments where the medium is solely a propagating transitory signal of the type found to be non-statutory subject matter in *Nuijten*. Accordingly, there is no proper basis for the rejection under 35 U.S.C. §101.

Solely in the interest of advancing prosecution, Applicant has amended Claims 7, 9, 20, and 27 to recite “a non-transitory computer readable medium.” Applicant submits that Claims 7, 9, 20, and 27 cover statutory subject matter under 35 U.S.C. § 101 and are worded according to USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 23 February 2010). Amendment of Claims 7, 9, 20, and 27 to include “non-transitory” is done, however, under protest.

Applicant respectfully submits that the requirement to use “non-transitory” is without authority. Applicant’s use of “non-transitory” is to be understood only to remove propagating transitory signals *per se* from the claim scope and does not relinquish rights to all standard computer readable media that are not just propagating transitory signals *per se*. In other words, the meaning of “non-transitory computer readable medium” should be construed to exclude only those types of transitory computer readable media which were found in *Nuijten* to fall outside the scope of patentable subject matter under 35 U.S.C. §101.

#### **IV. Claim Objections**

On page 3 of the Office Action, Claims 13 and 22 were objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 13 and 22 have been canceled. Accordingly, Applicant respectfully requests withdrawal of the claim objections.

#### **V. Claim Rejections under 35 U.S.C. § 102**

On page 3 of the Office Action, Claims 1, 2, 7, 8, 10-12 and 15-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Le (U.S. 6,300,887). Applicant respectfully traverses this rejection.

**A. Le fails to disclose the claimed “receiving, at the first network element, a portion of the header compression state information from the mobile node.”**

Independent Claim 1 as amended recites in part “receiving, at the first network element, a portion of the header compression state information from the mobile node.” Claim 7, although of different scope, contains a similar element. Independent Claim 15 recites in part “sending at least a portion of header compression state information from the mobile node to the first network element as part of the handoff procedure.” Independent Claim 20, although of different scope, contains a similar element. On pages 4 and 5 of the Office Action, the Examiner asserts that Figure 5 and Col. 2, ll. 30-65 and Col. 3, ll. 25-44 teach these elements. Applicant respectfully disagrees and submits that the cited portions of Le fail to disclose both the claimed “receiving, at the first network element, a portion of the header compression state information from the mobile node” and “sending at least a portion of header compression state information from the mobile node to the first network element as part of the handoff procedure.”

Col. 2, ll. 30-65 of Le provide:

IP/UDP/RTP header compression schemes, as described for example in RFC 2508, S. Casner, V. Jacobson "Compressing IP/UDP/RTP Headers for Low Speed Serial Links, Internet Engineering Task Force, February 1999, which is incorporated herein by reference in its entirety, take advantage of the fact that certain information fields carried in the headers either 1.) do not change ('Type 1' header fields) or 2.) change in a fairly predictable way ('Type 2' header fields). Other fields, referred to as 'Type 3' header fields, vary in such a way that they must be transmitted in some form in every packet (i.e. they are not compressible).

Examples of Type 1 header fields are the IP address, UDP port number, RTP SSRC (synchronization source), etc. These fields

need only be transmitted to the receiver/ decompressor once during the course of a session (as part of the packet(s) transferred at session establishment, for example). Type 1 fields are also called 'unchanging' fields.

Examples of Type 2 header fields are the RTP timestamp, RTP sequence number, and IP ID fields. All have a tendency to increment by some constant amount from packet (n) to packet (n+1). Thus, there is no need for these values to be transmitted within every header. It is only required that the receiver/decompressor be made aware of the constant increment value, hereafter referred to as the first order difference (FOD), associated with each field that exhibits this behavior. Receiver/decompressor utilizes these FODs to regenerate up-to-date Type 2 field values when reconstructing the original header. Type 2 fields are part of 'changing' fields.

It should be emphasized that, on occasion, Type 2 fields will change in some irregular way. Frequency of such events depends on several factors, including the type of media being transmitted (e.g., voice or video), the actual media source (e.g., for voice, behavior may vary from one speaker to another), and the number sessions simultaneously sharing the same IP-address.

Thus, Le discloses three types of data contained in header fields. Type 1 information does not change, while Type 2 information changes in a predictable way. This portion of Le is silent in regard to "header compression state information." This portion also fails to mention "sending" or "receiving" "a portion of the header compression state information." Applicant asserts that a description of Type 1 and Type 2 information is not the same as the claimed "receiving, at the first network element, a portion of the header compression state information from the mobile node" or the claimed "sending at least a portion of header compression state information from the mobile node to the first network element as part of the handoff procedure."

Column 3, lines 25-44 of Le state:

First Order (FO): Contains minimal header information (e.g. Type 3 fields), compressor/decompressor specific control fields (specific to the compression algorithm in use), and information describing

changes in current FOD fields. An FO packet is basically an SO packet (described below), with additional information that establishes new FOD information for one or more Type 2 fields at the decompressor. If the header compression is being applied to a VoIP (voice over internet protocol) stream, transmission of an FO packet might be triggered by the occurrence of a talk spurt after a silence interval in the voice. Such an event results in some unexpected change in the RTP timestamp value, and a need to update the RTP time stamp at the receiver by a value other than the current FOD. The size of FO packets depends on the number of Type 2 fields whose first order difference changed (and the amount of the absolute value of each change). When the compressor transmits FO packets, it is said to be in the 'FO state'.

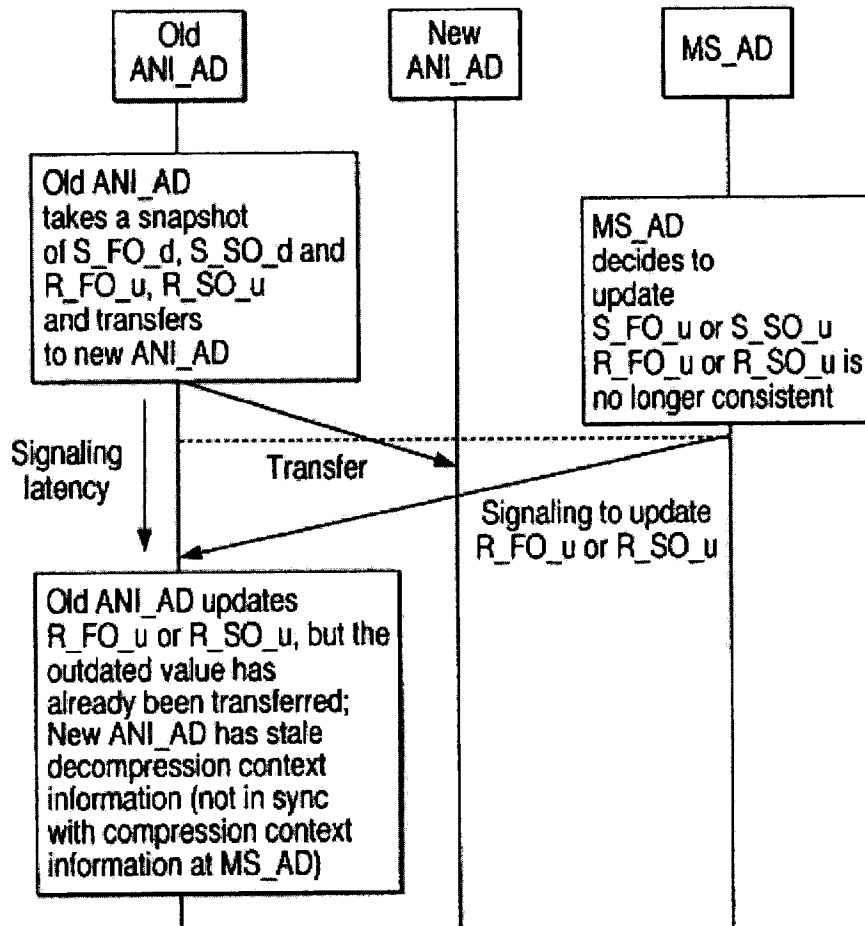
Thus, this section of Le discloses a first order header, which corresponds to Type 3 information. An example of when first order header is sent is when there is a talk spurt after a silence in a VoIP stream. This portion of Le does not mention “header compression state information.” This portion also fails to mention “sending” or “receiving” “a portion of the header compression state information.” Applicant asserts that a description of a first order header information or sending a first order header based upon events in a VoIP stream are not the same as the claimed “receiving, at the first network element, a portion of the header compression state information from the mobile node” or the claimed “sending at least a portion of header compression state information from the mobile node to the first network element as part of the handoff procedure.”

Finally, Figure 5, provided in full below, fails to illustrate the mobile state (MS) sending anything to the New ANI\_AD. Rather, Figure 5 illustrates the mobile station “Signaling to update R\_FO\_u and R\_SO\_u” to the Old ANI\_AD. In regard to the New ANI\_AD, the Examiner asserts on page 3 of the Office Action the “first networked element, described as an Access Network Infrastructure (ANI) 120 or new ANI.” Accordingly, Figure 5 does not illustrate the claimed “**receiving, at the first network element**, a portion of the header compression state information from the mobile node.” (Emphasis added). Additionally, Applicant asserts that Figure 5 fails to illustrate “sending at least a portion of header compression state information

from the mobile node to the first network element as part of the handoff procedure.”

(Emphasis added).

**FIG. 5**



For at least the above reasons, Applicant respectfully requests the withdrawal of the rejection from the pending claims.

#### **VI. Allowable Subject Matter**

On page 5 of the Office Action, the Examiner notes that Claims 3 and 14 are allowed, and that Claims 21 and 24-26 would be allowable if rewritten to overcome the rejection(s) under 35

U.S.C. § 112, 2nd paragraph, set forth in this Office action. As noted above, Applicant asserts that these rejections have been overcome. Applicant thanks the Examiner for indicating the allowability of these claims.

\* \* \*

Applicant submits that, for at least the foregoing reasons, all claims of the present application are patentable over the cited prior art. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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